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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,364	12/21/2001	Christen K. Pedersen	100110549	4967

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

BECK, ALEXANDER S

ART UNIT	PAPER NUMBER
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2629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/032,364

Applicant(s)

CHRISTEN K. PEDERSEN

Examiner

Alexander S. Beck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 2, 2006 has been entered.

Claims 1-27 are currently pending in U.S. Application Serial No. 10/032,364, and an Office Action on the merits follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1-27** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

As to independent **Claims 1, 10 and 16**, there is no support in the specification for the negative limitation "*so that sensors are not required to detect movement of said display projection system*". Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which

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does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. See MPEP 2173.05(i).

4. Furthermore, **Claims 1-27** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue.” These factors include, but are not limited to: (1) The breadth of the claims; (2) The nature of the invention; (3) The state of the prior art; (4) The level of one of ordinary skill; (5) The level of predictability in the art; (6) The amount of direction provided by the inventor; (7) The existence of working examples; and (8) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

4(a). Factors 1&2 – The breadth of the claims and nature of the invention.

The claims are drawn to a display projection system comprising optical collimation and function selection. As recited in the claimed limitations, the function selection is achieved by “*tilting and rotating said display projection system resulting in a change in an angle of said projected display to align a dot with a visual representation of said function*”.

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4(b). Factors 3&5 – The state of the prior art and level of predictability in the art.

With respect to the method of function selection discussed above, it is art recognized that when two separate images (e.g. projected display and dot) are displayed by a common and single display projection system, the tilting and rotating of said display projection system results in the rotation of both the projected display and dot, assuming that the dot is not projected along the axis of rotation. If the dot is projected along the axis of rotation, it is art recognized that while the projected display may rotate about dot, a visual representation of said function cannot align with the dot unless that specific visual representation was provided on the axis of rotation as well. Thus, it is art recognized that the tilting and rotating of said display projection system cannot result in the alignment of a dot with a visual representation of said function, both of which are projected by the display projection system.

4(c). Factor 4 - The level of one of ordinary skill.

The level of skill would most likely be an Electrical Engineer.

4(d). Factors 6&7 - The amount of direction provided by the inventor and existence of working examples.

Although not disclosed expressly in the Request for Continued Examination, it appears that page 10, lines 13 through 26 of the specification are directed towards the method of function selection comprising tilting and rotating the display projection system. This section, in its entirety, reads as follows:

CPD (cursor placement device) 303, shown in one embodiment below MISP 302, is for controlling a cursor. In one embodiment, as the projection display device projects a display, for example web page 550 of Figure 5A, there is a displayed dot within the projected display. To select a function of the display or to go to a different web page, e.g., web page 551 of Figure 5B, a user tilts and rotates PTPED 100. This changes the angle of the projection, as controlled by display projection controller 610 of Figure 6A, and while the projected display is moved/repositioned, the dot remains in the same place. The user then aligns the dot with the function to be performed or to a web page link to which the user wishes to view, and then clicks on CPD 303 to initiate the action.

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The specification is silent as to where the displayed dot is projected from. If the dot is in fact projected from the same source as the projected display, the specification is silent as to how the dot remains stationary while aligning with the function to be performed of the projected display.

4(e). Factor 8 - The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

As a result of the lack of specific guidance from the specification, the examiner contends that the quantity of experimentation needed to make and or use the invention would be great. Note that there must be sufficient disclosure, either through illustrative examples or terminology, to teach those of ordinary skill how to make and use the invention as broadly as it is claimed. In re Vaeck, 947 F.2d 488, 496 & n.23, 20 USPQ2d 1438, 1445*n.23 (Fed. Cir. 1991).

In this case, Applicants have not provided any working examples that would teach the method of function selection wherein tilting and rotating said display projection system results in a change in an angle of said projected display to align a dot with a visual representation of said function. Due to the inadequacies of the instant disclosure, one of ordinary skill in the art would not have a reasonable expectation of success and the practice of the full scope of the invention would require undue experimentation.

Based on the evidence as a whole regarding each of the above factors (i.e. Factors 1-8), the specification, at the time the application was filed, does not satisfy the enablement requirement for the claimed limitation of function selection wherein tilting and rotating said display projection system results in a change in an angle of said projected display to align a dot with a visual representation of said function.

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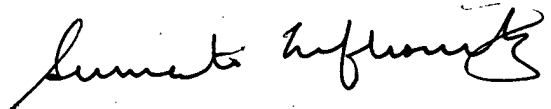
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Alexander S. Beck** whose telephone number is **(571) 272-7765**. The examiner can normally be reached on M-F, 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Sumati Lefkowitz** can be reached on **(571) 272-3638**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

asb
1/18/07



**SUMATI LEFKOWITZ
SUPERVISORY PATENT EXAMINER**